

Remarks

Claims 1-2, 4-5, 7-10, and 13-24 are pending in this application. Claims 3, 6, 11, and 12 have been canceled without prejudice. Applicant reserves the right to file one or more continuing applications directed to the subject matter of these canceled claims. Claims 1, 7, and 9 have been amended to specify that the structure for attaching additional fronts, backs, and bottoms is a flange. Support for these changes is found, for example, at page 15, lines 6-15. Claims 13-24 are new. Claims 22 and 24 also contain recitations of such flanges, for which there is support at page 15, lines 6-15. Claims 13-14, 16-22, and 24 are drawn to a planter comprising hinges for connecting a front wall and a back wall to a bottom. Support for such hinges is found, for example, at page 14, lines 14-15. Claims 14-15, 17, and 23-24 relate to a planter comprising a top bracket. Support for this structure is found, for example, at page 15, lines 16-21. Thus, no new matter is added to this application by virtue of these amendments.

The application currently contains three independent claims and 20 total claims. Thus, no additional claims fees are required. Nevertheless, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment in connection with this paper to Deposit Account No. 50-0836.

I. Response to Rejections Under 35 U.S.C. § 103

A. Legal Standards Under 35 U.S.C. § 103

Before responding directly to the issues raised by the Examiner under Section 103, the legal foundation for sustaining such a rejection will be reviewed. Briefly, an applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. *E.g.*, 35 U.S.C. §§ 102, 103. It is the PTO's duty to issue a patent or establish that the applicant is not entitled under the law to a patent. *In re Warner*, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Thus, the burden is on the PTO to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If no *prima facie* case of obviousness is established, then a rejection under Section 103 cannot properly be sustained. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). If the PTO establishes a *prima facie* case of obviousness, then the burden of production shifts to the applicant to provide appropriate rebuttal, although the burden of persuasion always remains with the Patent Office. *Id.* Such rebuttal may include arguments, amendments, and/or presentation of objective indicia of nonobviousness. However, such objective indicia are always relevant to a determination of nonobviousness whether or not a *prima facie* case of obviousness has been established. *Stratoflex Inc. v. Aeroquip*

*Corp.*, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1987). To establish a *prima facie* case of obviousness, the PTO must show all of the limitations of the claimed invention in the prior art. *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). The subject matter of the invention must be considered as a whole and through the eyes of a hypothetical person of ordinary skill, not expert skill, in the relevant art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). References must also be considered as a whole, including subject matter that teaches away from the invention as well as subject matter that suggests the invention, and not for their isolated teachings. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 U.S.P.Q. 657, 669 (Fed. Cir. 1985). References may be combined if there is a suggestion, motivation, or incentive in the prior art to make such a combination. *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (*en banc*); *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992). It is not permissible to use hindsight to pick and choose among isolated teachings in the art after first having read Applicant's application to learn the pattern of the invention. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Finally, all the facts in evidence are evaluated, and patentability is determined on the totality of the record. *In re Corkill*, 226 USPQ 1005, 1008 (Fed. Cir. 1985). Factual

determinations made by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. *In re Caveny*, 226 USPQ 1, 3 (Fed. Cir. 1985).

Pursuant to established legal authority, patentability under 35 U.S.C. § 103 requires a four-step analysis, which involves determining (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed inventions, (3) the level of skill in the art, and (4) the objective evidence of nonobviousness that may have been presented. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 311, 314 (Fed. Cir. 1983). After all of these factors have been considered, the ultimate legal conclusion on the issue of obviousness must be reached. With the above background in mind the rejections under 35 U.S.C. § 103 will be discussed.

B. Response to Rejection of Claims 1-12 over U.S. Patent No. 986,395 in view of U.S. Patent No. 5,741,339 and German Patent No. DE 3307428A1

Claims 1-12 were rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over U.S. Patent No. 986,395 ("King") in view of U.S. Patent No. 5,741,339 ("DuMars") and German Patent No. DE 3307428A1 ("Juergens").

King discloses a plant and flower pot having a plurality of receptacles, each having four vertical sides, two of which are

parallel to each other and two of which are not parallel to each other, in combination with mortises and clamps for connecting the receptacles.

DuMars describes cementitious planter building blocks for the landscaping of vertical block walls. These planter building blocks are cantilevered, protruding, open-topped blocks having a front, back, two sides, and a bottom. Attached to the back are two protruding vertical walls 24 and 25 into which support grooves 26 and 27 are configured. A support (FIG. 3) is set into the vertical block wall. This support includes front vertical surfaces 39, 40, and 41 containing support grooves 43, 44, and 45. A piece of reinforcing steel is placed into aligned grooves 26, 27, 43, 44, and 45 to hold the planter to the wall.

Juergens discloses a planter having a curved side wall 2 attached to a bottom 5. The side wall 2 has multiple holes 3 in it. Pockets 4 are attached to the outer surface of the side wall 2 and are associated with the holes 3 for holding plants. The planter has an open top 7, which is configured for receiving the bottom 5 of another planter so that multiple planters can be stacked vertically (FIG. 2).

The combination of King, DuMars, and Juergens fails to show or suggest (1) flanges disposed on the side walls for permitting attachment of additional front walls, back walls, and bottoms

(claims 1, 2, 4, 5, 7-10, 13-15, 22, and 24); (2) a front wall and a back wall disposed on a bottom with hinges (claims 13, 14, 16-22, and 24); or (3) a bracket disposed on a front wall, back wall, and side walls (claims 14, 15, 17, 23, and 24).

Therefore, the Office Action has failed to show each and every limitation of the presently claimed invention in the prior art, as required by *Ehhreich* for establishing a *prima facie* case of obviousness. For these reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established as to any of the claims currently under consideration. Hence, Applicants respectfully request that the rejection of claim 1-12 under 35 U.S.C. § 103(a) over King in view of DuMars and Juergens be withdrawn.

## II. Conclusion

Should the Examiner deem it advisable to conduct a telephone interview for any reason, the undersigned attorney would be most agreeable to receiving a telephone call to expedite the prosecution of the application.

For the reasons given above, Applicants respectfully request reconsideration and allowance of Claims 1, 2, 4, 5, 7-10, and 13-24 and passage of this application to issue.

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Respectfully submitted,



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